

**REMARKS**

**Summary of the Office Action**

Applicants' election of Group I (claim 1-9) and the species of FIG. 2 drawn to claims 1-2 and 5-9 is acknowledged, and therefore claims 3-4 and 10-12 are withdrawn from further consideration pursuant to 37 CFR 1.142(b).

FIGS. 7-9 should be each designated by a legend such as "Prior Art."

The disclosure stands objected to because of informalities.

Claims 1, 3, 5 and 7-9 stand objected to because of particular alleged informalities.

Claims 5-6 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement.

Claim 5 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.

Claims 1-2 and 8-9 stand rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent No. 6,353,588 to Ori (hereinafter "Ori").

Claim 1 stands rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent No. 6,646,817 to Katsuma (hereinafter "Katsuma").

Claim 7 stands rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Katsuma in view of U.S. Patent No. 6,310,733 to Dolgoff (hereinafter "Dolgoff").

**Summary of the Response to the Office Action**

Applicants have amended claims 1, 3, 5, 7-10 and 12 to differently describe the invention and improve their form. The Specification has been amended at page 13, line 22, page 14, line 22, page 14, line 24 and page 15, line 20 in response to the Examiner's comments in the Office

Action. FIGS. 7-9 have been amended to add the legend "Prior Art" in accordance with the Examiner's suggestion in the Office Action.

In addition, Applicants submit a verified translation of Japanese Patent Application No. 2000-175230 concurrently herewith.

**Objection to the Drawings**

FIGS. 7-9 should be each designated by a legend such as "Prior Art." Applicants have amended FIGS. 7-9 to add the legend "Prior Art" in accordance with the Examiner's suggestion in the Office Action. Accordingly, Applicants respectfully request that the objection to the drawings be withdrawn.

**Objection to the Disclosure**

The disclosure stands objected to because of informalities. Applicants have amended the specification by adopting the Examiner's helpful suggestions as set forth at page 3, section 4 of the Office Action. Accordingly, Applicants respectfully request the objection to the disclosure be withdrawn.

**Objection to the Claims**

Claims 1, 3, 5 and 7-9 stand objected to because of informalities. Applicants have amended claims 1, 3, 5, and 7-9 by adopting the Examiner's helpful suggestions as set forth at page 3, section 6 of the Office Action. Accordingly, Applicants respectfully request the objection to claims 1, 3, 5 and 7-9 be withdrawn.

**Rejections under 35 U.S.C. §112, first paragraph**

Claims 5 and 6 stand rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement. Specifically, the Office Action alleges that “[c]laims 5 and 6 limit the center curvature of the convex aspherical surface shape of the first optical element to a specified range that is dependent on the volumes of the first and second optical elements,” but “[n]o volume is disclosed for the second optical element and the range center curvature radii is not explicitly disclosed.” The Office Action goes on to indicate that “[o]ne skilled in the art has no way of determining the range of acceptable center curvature radii of the first optical element because the volume of the first optical element is not provided for the elected species of Fig. 2.”

However, Applicants respectfully submit that claims 5-6 read on the elected species of FIG. 2 as well as at least the non-elected species of FIG. 4. Moreover, the volumes of the first and second optical elements in claims 5-6 are described at least with regard to the “First example” and “Second example” at page 16, line 17 to page 23, line 3 of the specification, which are examples for both the elected species of FIG. 2 and non-elected species of FIG. 4. Accordingly, Applicants respectfully request the rejection of claims 5 and 6 under 35 U.S.C. § 112, first paragraph, be withdrawn.

**Rejections under 35 U.S.C. §112, second paragraph**

Claim 5 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Specifically, the Office Action alleges that “[i]t is unclear how a range of length can be equal to and larger than another length,” and suggests to change “and” at line 4 of claim 5 to --or--.

Since Applicants have amended claim 5 by adopting the Examiner’s helpful suggestion,

Applicants respectfully request the rejection of claim 5 under 35 U.S.C. § 112, second paragraph, be withdrawn.

**Rejections under 35 U.S.C. §§ 102(e) and 103(a)**

Claims 1-2 and 8-9 stand rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Ori, claim 1 stands rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Katsuma, and claim 7 stands rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Katsuma in view of Dolgoff. To the extent that these rejections might be applied against the claims as newly-amended, they are respectfully traversed for at least the following reasons.

**(I) Rejection under 35 U.S.C. § 102(e) based on Ori**

With regard to rejection of claims 1, 8 and 9 under 35 U.S.C. § 102(e) based on Ori, Applicants respectfully submit that Ori does not teach or suggest the claimed complex objective lens, optical pickup device and optical recording/reproducing apparatus including at least the recited features that “the opposite side surface opposing the first surface of the first optical element and the entry surface opposing the exit surface of the second optical element are both flat and directly contacted to each other,” as recited by each of newly-amended independent claims 1, 8 and 9.

The Office Action appears to allege that Ori discloses all the limitation of independent claims 1, 8 and 9 by citing to Fig. 1 of Ori. However, as shown in Fig. 1 of Ori, while an opposite side surface R2 and an entry surface R3 are directly contacted to each other, they are not flat. In contrast to the claimed invention, Applicants respectfully submit that Ori neither teaches nor suggests a complex objective lens, an optical pickup device and an optical

recording/reproducing apparatus each including at least the above-mentioned features in each of newly-amended independent claims 1, 8 and 9.

Accordingly, withdrawal of the rejection of claims 1, 8 and 9 under 35 U.S.C. § 102(e) based on Ori is respectfully requested.

**(II) Rejection under 35 U.S.C. § 102(e) based on Katsuma**

With regard to rejection of claim 1 under 35 U.S.C. § 102(e) based on Katsuma, Applicants respectfully submit that Katsuma does not cure the deficiencies of Ori. That is, Katsuma also fails to teach or suggest the claimed complex objective lens including at least the features that “the opposite side surface opposing the first surface of the first optical element and the entry surface opposing the exit surface of the second optical element are both flat and directly contacted to each other,” as recited by newly-amended independent claim 1.

In addition, Applicants respectfully submit that Katsuma should not be considered as prior art in the present application under any subsection of 35 U.S.C. § 102. On September 10, 2001, Applicants filed a Claim for Priority and a Certified copy of Japanese Patent Application No. 2000-175230 which was filed in Japan on June 12, 2000. Pursuant to 37 C.F.R. § 1.55(a), Applicants submit concurrently herewith a verified translation of Japanese Patent Application No. 2000-175230. The U.S. filing date of Katsuma is May 25, 2001 which is after the priority date to which this application is entitled. Thus, Applicants respectfully submit that Katsuma should not be considered as prior art in the present application under any subsection of 35 U.S.C. § 102.

Accordingly, withdrawal of the rejection of claim 1 under 35 U.S.C. § 102(e) based on Katsuma is respectfully requested.

**(III) Rejection under 35 U.S.C. § 103(a) based on Katsuma in view of Dolgoff**

With regard to the rejection of claim 7 based on Katsuma in view of Dolgoff, Applicants respectfully submit that Katsuma should not be considered as prior art in the present application, as discussed above. In addition, Applicants respectfully submit that Dolgoff does not cure the deficiencies of Ori and Katsuma. That is, Dolgoff also fails to teach or suggest at least the above-mentioned features.

Accordingly, withdrawal of the rejection 35 U.S.C. § 103(a) of claim 7 based on Katsuma in view of Dolgoff is respectfully requested.

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For at least the forgoing reasons, Applicants respectfully assert that the rejections of claims 1, 8 and 9 under 35 U.S.C. § 102(e) and the rejection of claim 7 under 35 U.S.C. § 103(a) should be withdrawn because the applied references, whether taken singly or combined, do not teach or suggest each feature of independent claims 1, 8 and 9, as newly-amended. As pointed out in MPEP § 2131, "[t]o anticipate a claim, the reference must teach every element of the claim." Thus, "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Verdegaal Bros. v. Union Oil Co. Of California, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987)." Similarly, MPEP § 2143.03 instructs that "[t]o establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 409 F.2d 981, 180 USPQ 580 (CCPA 1974)." Furthermore, Applicants respectfully assert that dependent claims 2 and 5-7 are allowable at least because of their dependencies from independent claim 1 and the reasons set forth above.

With no other rejections pending, Applicants respectfully assert that claims 1, 2 and 5-9 are in condition for allowance.

**Conclusion**

In view of the foregoing remarks, Applicants respectfully request reconsideration and the timely allowance of the pending claims. Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact Applicants' undersigned representative to expedite prosecution.

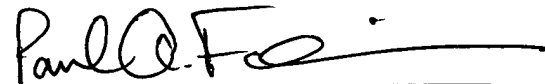
**Except** for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. §§ 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account No. 50-0310.

Respectfully submitted,

**MORGAN, LEWIS & BOCKIUS LLP**

Dated: August 9, 2004

By: \_\_\_\_\_



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